

## REMARKS

Applicants respectfully request favorable reconsideration and reexamination of this application.

Claims 1, 14, and 17 have been revised. Revisions in the claims are supported by, for example, page 8, lines 17-27, page 37, line 27 to page 38, line 5, and Figs. 1, 9, and 10 in the Specification. There is no new matter. Claims 1-20 are pending. Claims 15-20 have been withdrawn from consideration.

### Election/Restrictions

Applicants traverse the restriction requirement. The Examiner maintained the restriction requirement by relying on MPEP 821.03 and stated that the restriction requirement is justified because “claims 15-20 are drawn to a method and a first action on the merits have been made on claims 1-14 drawn to the product” (page 2 of the Office Action).

Applicants respectfully submit that claims 17-18 are not drawn to a method. Claim 17 recites “An image-added retroreflective sheet for security, comprising ...” Claim 18 recites “The image-added retroreflective sheet for security according to claim 17, further comprising ...” Thus, it is clear that claims 17-18 are drawn to an apparatus. Therefore the reason provided for the restriction of claims 17-18 is unreasonable.

Further, merely because claims 15-16 and 19-20 are directed towards a process and claims 1-14 are directed towards a product does not necessarily make the claims 15-16 and 19-20 distinct from and independent of the invention claimed in claims 1-14. Claims 1-14 and 15-16 and 19-20 have a technical relationship such that unity of invention is applicable.

“Unity of invention (not restriction practice) is applicable in international applications and in national stage applications submitted under 35 U.S.C. 371” (MPEP 1893.03(d)).

Applicants once again bring to the Examiner’s attention that one or a group of inventions may be linked as to form a single general inventive concept. This “unity of invention” requirement is fulfilled when a group of inventions claimed in an application has a technical relationship among those inventions involving one or more of the same or corresponding technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

37 CFR § 1.141(b) states that “where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made” (emphasis added).

Applicants respectfully submit that the claims 1-14 and 17-18 are directed to a product and claims 15-16 and 19-20 are directed to a process specially adapted for the manufacture of said product. Accordingly, claims 1-20 have unity of invention, and the claims should be considered jointly under CFR § 1.141(b).

Also in maintaining the restriction, the Examiner stated that “since applicant [sic] has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits” (page 2 of the Office Action). The Examiner improperly relied on MPEP 821.03 in maintaining the restriction.

MPEP 821.03 states “if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.”

MPEP 1893.03(d) states if the examiner finds that there is a lack of unity of invention in the claims, “the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.”

Accordingly, if the Examiner is asserting that the restriction can be maintained because claim revisions have made claims 15-20 distinct from and independent of the invention claimed in claims 1-14, the Examiner must explain why claims 15-20 lack unity with claims 1-14 specifically describing the unique special technical features in the claims. The Examiner has failed to provide such explanation. Merely stating that claims 15-20 are directed towards a process and claims 1-14 are directed towards a product does not satisfy the requirement under MPEP 1893.03(d).

Therefore, no adequate basis has been established for the restriction requirement and/or no adequate basis exists due to the claim revisions. Applicants request that the restriction requirement be withdrawn.

Claim Rejections 35 USC § 112

Claims 1-14 were rejected under 35 USC 112, second paragraph. The rejection stated that it was not clear as what is meant by “the high-refractive glass beads are disposed in a part of the binder layer where the print resin layer is not formed” recited in claims 1 and 14. Claims 1 and 14 have been revised to address the rejection. Claims 1 and 14 recite “the high-refractive-index glass beads are disposed in the binder layer on which the print resin layer is not formed, and the high-refractive-index glass beads are not present between the print resin layer and the metal layer.” Applicants respectfully submit that claims 1-14 are understandable to one skilled in the art. Applicants respectfully request that the rejection be withdrawn.

Claim Rejections 35 USC § 103

Claims 1-4, 6, 7, and 14 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al. (US 5866236) in view of Ochi et al. (US 5912316) and further in view of Araki et al. (US 5714223). Applicants respectfully traverse the rejection.

Regarding claim 1, the rejection asserted that Faykish et al. teaches a sheet having all of the recited layers except for the surface layer. Applicants do not concede that the rejection has correctly identified the recited layers. The rejection asserts that Faykish et al. teaches a sheet having layers in the following order:

- a binder layer (70),
- a high-refractive index glass beads (60)
- a print resin layer (170),
- a focusing layer (120),
- a metal layer (30), and
- a pressure-sensitive adhesive layer (150).

The reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Therefore,

Faykish et al. must be considered in its entirety, including any portions that would teach a surface layer which may teach away from the claims.

Applicants respectfully submit that Faykish et al. in fact does teach a surface layer structure (160) in Fig. 1. Faykish et al. teaches that in Fig. 1, adhesive 150 is “covered by a removable liner 160, as shown in Fig. 1, to protect the adhesive from contamination” (column 5, lines 12-14). Accordingly, assuming arguendo that the rejection has correctly designated the recited layers, which Applicants do not concede, Faykish et al. teaches a sheet having layers in the following order:

- a binder layer (70),
- a high-refractive index glass beads (60)
- a print resin layer (170),
- a focusing layer (120),
- a metal layer (30),
- a pressure-sensitive adhesive layer (150), and
- a surface layer (160).

Or, alternatively, starting from the surface layer side, in the following order:

- a surface layer (160).
- a pressure-sensitive adhesive layer (150),
- a metal layer (30),
- a focusing layer (120),
- a print resin layer (170),
- a binder layer (70), and
- a high-refractive index glass beads (60).

The rejection improperly ignored the surface layer (160) taught in Faykish et al. Further, the rejection merely made a conclusory statement that Ochi et al. teaches a “protective film” which would provide “high mechanical strength” but provided no explanation of why or how one skilled in the art would modify the layers of the sheet taught in Faykish et al. to achieve the order of the layers recited in claim 1 (pages 6 and 8 of the Office Action). The rejection has been made with improper hindsight reasoning based on Applicants’ disclosure.

Further, Applicants respectfully submit that the rejection incorrectly identified the tie layer (120) to be the recited focusing layer. Faykish et al. teaches that the tie layer (120) is

merely an adhesive that bonds together a holographic layer and a retroreflective layer (see column 4, lines 41-58). Faykish et al. does not even suggest that the tie layer (120) has any feature such that it could be considered to be identified as the recited focusing layer. Faykish et al. teaches that "light that enters the retroreflective layer is focused by the glass microspheres through the spacing resin 70, and reflected by the reflector layer back through the spacing resin and glass microspheres to an observer" (column 3, lines 47-57). Accordingly, Applicants respectfully submit that the spacing resin (70) may be designated to be the recited focusing layer, but because the Examiner has already designated the spacing resin (70) to be the recited binder layer, it cannot again serve as the separately recited focusing layer. The rejection must identify another structure to satisfy this limitation. Otherwise, the rejection would be mischaracterizing the language of the claim.

Regarding the other recited layers identified in the rejection, Applicants do not concede the correctness of the identification of the recited layers. However, assuming arguendo that the rejection has identified layers that are recited in claim 1, Faykish et al. fails to teach the layers and the order of the layers recited in the claim.

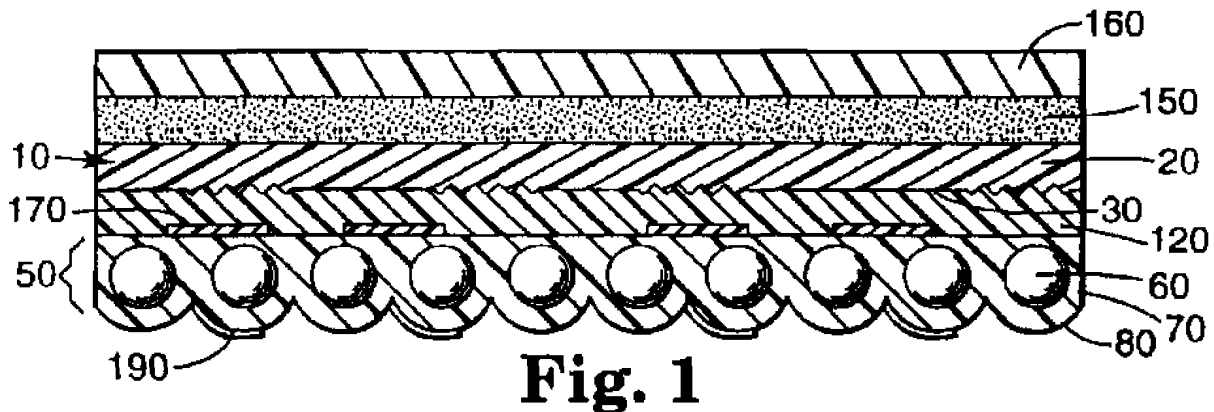


Fig.1 of Faykish et al.

Fig. 1 of Faykish et al. teaches a sheet comprising, in order from the surface layer (160) side and along the thickness of the sheet:

- a surface layer (160),
- a pressure-sensitive adhesive layer (150),
- a metal layer (30),
- a print resin layer (170),

a binder layer (70), and  
a high-refractive index glass beads (60).

In contrast, claim 1 recites a retroreflective sheet for security comprising, in this order along a thickness direction:

a surface layer,  
a binder layer,  
high-refractive-index glass beads,  
a print resin layer,  
a focusing layer,  
a metal layer, and  
a pressure-sensitive adhesive layer.

Thus Faykish et al. does not teach the recited focusing layer, or the order of the layers recited in claim 1.

Further, assuming arguendo, that the “optional patterned coating layer 170” shown in Fig. 1 of Faykish et al. satisfies the recited “print resin layer,” Faykish et al. teaches that the patterned coating layer (170) is provided on the side that is towards the surface layer (160) side from the binder layer (70).

In contrast, claim 1 recites a retroreflective sheet for security, wherein the print resin layer is formed on a part of the binder layer opposite to the surface layer side, and when being observed from the surface layer side in the thickness direction of the retroreflective sheet for security, the print resin layer forms a mark.

Further, Fig. 1 of Faykish et al. clearly shows that at least one position of high-refractive-index glass beads (60) coincide with a position of the print resin layer (170), when being observed from the surface layer side in the thickness direction of the sheet.

In contrast, claim 1 recites a position for disposing the high-refractive-index glass beads does not coincide with a position of the print resin layer at all, when being observed from the surface layer side in the thickness direction of the retroreflective sheet for security.

Fig. 2 of Faykish et al. also fails to teach the layers and the order of the layers recited in claim 1. Faykish et al. teaches a surface layer to be “a durable cover film 140 may also be provided, as shown in Fig. 2, to protect the article from degradation due to environmental conditions” (column 4, lines 59-61).

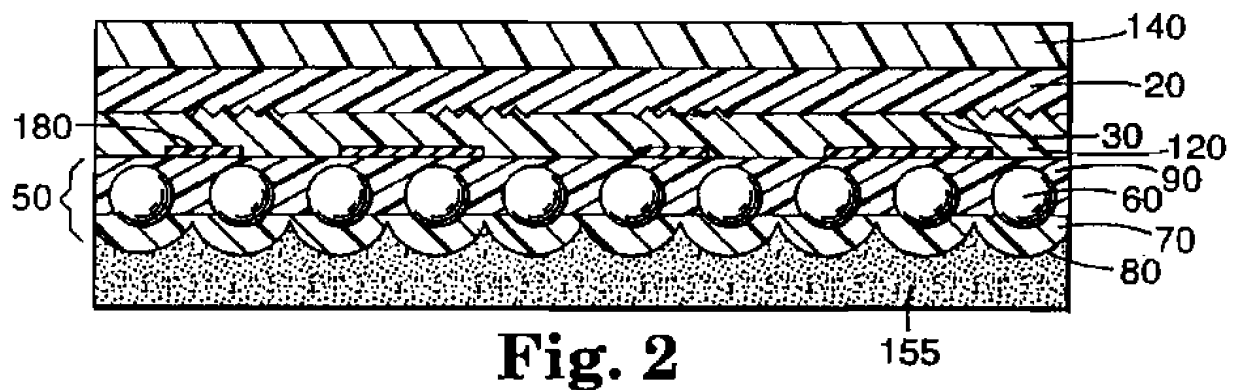


Fig.2 of Faykish et al.

Fig. 2 of Faykish et al. shows a sheet comprising, in order from the surface layer (140) along the thickness of the sheet:

- a surface layer (140),
- a metal layer (30),
- a high-refractive index glass beads (60),
- a binder layer (70), and
- a pressure-sensitive adhesive layer (155).

In contrast, claim 1 recites a retroreflective sheet for security comprising, in this order along a thickness direction of a retroreflective sheet for security:

- a surface layer,
- a binder layer,
- high-refractive-index glass beads,
- a print resin layer,
- a focusing layer,
- a metal layer, and
- a pressure-sensitive adhesive layer.

Thus Fig. 2 of Faykish et al. also does not teach the recited focusing layer, or the order of the layers recited in claim 1.

Further, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The Examiner cannot satisfy this burden through “mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.” *KSR Int’l. v. Teleflex Inc.* 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1396 (2007) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006)). In *KSR*, the United States Supreme Court affirmed the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the claim and the prior art; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluation of evidence of secondary considerations. Accordingly, the rejection must address all limitations of the claims. Further, the rejection must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and “[such] analysis should be made explicit,” *KSR*, 127 S.Ct. at 1741.

The rejection failed to show how the Faykish et al. and the other cited art teach the order of layers recited in claim 1. Further, the rejection does not provide any analysis as to how and/or why a person skilled in the art would modify the order of the layers taught in Faykish et al. to achieve the order of layers recited in claim 1.

Ochi et al. and Araki et al. do not remedy the deficiencies of Faykish et al. Claim 1 is patentable over Faykish et al. in view of Ochi et al. and further in view of Araki et al. Claims 2-4, 6, and 7 are patentable for at least the same reasons as claim 1 from which they depend. Claim 14 is patentable for at least the same reasons as claim 1. Applicants respectfully request a favorable reexamination and reconsideration of the claims.

Claim 5 was rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., and Araki et al., in view of Rivera et al. (US 2005/0179253) Applicants respectfully traverse the rejection. Rivera et al. does not remedy the deficiencies of Faykish et al., Ochi et al., and Araki et al. stated above in regard to claim 1. Claim 5 is patentable for at least the same reasons as claim 1 from which it depends. Applicants respectfully request that this rejection be withdrawn.

Claims 8-9 and 13 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., and Araki et al., in view of Pearce et al. (US 5342821). Applicants respectfully traverse the rejection. Pearce et al. does not remedy the deficiencies of Faykish et



al., Ochi et al., and Araki et al. stated above in regard to claim 1. Claims 8-9 and 13 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

Claims 10-12 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., Araki et al., and Pearee et al. in view of Bourdelais et al. (US 5342821). Applicants respectfully traverse the rejection. Bourdelais et al. does not remedy the deficiencies of Faykish et al., Ochi et al., Araki et al. and Pearce et al. stated above in regard to claims 1 and 8. Claims 10-12 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

Claims 8-13 were rejected under 35 USC 103(a) as being unpatentable over Faykish et al., Ochi et al., and Araki et al., in view of Yukawa et al. (US 2005/0148469). Applicants respectfully traverse the rejection. Yukawa et al. does not remedy the deficiencies of Faykish et al., Ochi et al., and Araki et al. stated above in regard to claim 1. Claims 8-13 are patentable for at least the same reasons as claim 1 from which they depend. Applicants respectfully request that this rejection be withdrawn.

In view of the above amendments and remarks, Applicants respectfully request a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned attorney-of record, Douglas P. Mueller (Reg. No. 30,300), at (612) 455-3804.



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